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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/085,566 | 02/27/2002 | Keiji Ohbayashi | 02126/HG | 8962 |

1933 7590 11/10/2003

FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
767 THIRD AVENUE
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NEW YORK, NY 10017-2023

EXAMINER

SHEWAREGED, BETELHEM

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1774

DATE MAILED: 11/10/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,566

Applicant(s)

OH BAYASHI ET AL.

Examiner

Betelhem Shewareged

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 17-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's response filed on 10/22/2003 has been fully considered.

Election/Restrictions

2. Applicant's election of Group I claims 1-16 in Paper No. 4 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Specification

3. The disclosure is objected to because of the following informalities: The specification refers to the claims (*for example, see page 45, line 19, page 48, line 15, page 49, line 20, page 53, line 1, page 54, line 10, and page 55, lines 5 and 21*).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-5, 7-10, 12 and 13 are rejected under 35 U.S.C. 102(a) as being anticipated by Tsubaki et al. (US 6,335,102 B1).

Tsubaki discloses a support for imaging material comprising a resin coated paper (abstract). Polyethylene is used as the resin to coat the paper, and is coated on both sides of the paper (col. 27, line 45 thru col. 28, line 5). The paper has a water content

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of 8% by weight (col. 27, line 40). An ink receiving layer is provided on the resin coated paper, wherein the ink receiving layer comprises a binder such as polyvinyl alcohol (col. 25, line 57), and a proper combination of additives such as surfactants, polymer curing agents (equivalent to the claimed hardener), antioxidant (equivalent to the claimed image stabilizer), inorganic particles, and pH adjusters (col. 26, lines 31-62). The process by which the porous layer is formed (see claims 1-5 and 9) is not dispositive of the issue of the patentability of the instant article claims.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5, 7, 9, 10 and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohbayashi et al. (US 6,492,005 B1).

The applied reference has a common inventor/assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this

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application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Ohbayashi discloses an ink jet recording sheet comprising a support and a porous ink absorptive layer (abstract). The ink absorptive layer comprises a hydrophilic binder and inorganic particles (col. 13, line 32). The ink absorptive layer further comprises hardeners, surface active agents, anti-fading agents (equivalent to the claimed image stabilizer), and pH adjusting agents (col. 15, line 26 and col. 16, lines 19-34). The ink absorptive layer further comprises water soluble polyvalent metal compounds (col. 18, line 8). The support is a polyethylene resin coated paper (col. 19, line 43). The process by which the porous layer is formed (see claims 1-5 and 9) is not dispositive of the issue of the patentability of the instant article claims.

8. Claims 1-5, 7, 9, 10, 12 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Sismondi et al. (US 6,387,473 B1).

Sismondi discloses ink jet recording sheet comprising a support and at least two ink receiving layers (abstract). The ink receiving layers comprise a hydrophilic polymer (col. 5, line 63), inorganic particles (col. 7, line 11), surfactants (col. 3, line 21), hardeners (col. 8, line 62), anti-oxidants and pH adjusting agents (col. 10, lines 37 and 40). The ink receiving layers are coated at the same time (col. 11, line 3). The support is a polyolefin resin coated paper (col. 5, line 5). The process by which the porous layer is formed (see claims 1-5 and 9) is not dispositive of the issue of the patentability of the instant article claims.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 6, 11, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tusbaki et al. (US 6,335,102 B1), as applied to claims 1-5, 7-10, 12 and 13 in paragraph # 5.

With respect to claim 6, Tusbaki teaches the claimed limitation except for wounding the recording sheet in a roll. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to wound the recording sheet in a roll since it was known in the art that storing a paper in a roll or in stack is commonly practiced.

With respect to claim 11, the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust viscosity of coating solutions of a recording medium in order to optimize the coating properties of a layer. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

With respect to claims 15 and 16, the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust pH value of coating solution(s) of a recording medium in order to optimize printing qualities after imaging. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

11. Claims 6, 11, 15 and 16 are rejected under 35 U.S.C. 103(a) as being obvious over Ohbayashi et al. (US 6,492,005 B1), as applied to claims 1-5, 7, 9, 10 and 12-14 in paragraph # 7.

The applied reference has a common inventor/assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the

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application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

With respect to claim 6, Ohbayashi teaches the claimed limitation except for wounding the recording sheet in a roll. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to wound the recording sheet in a roll since it was known in the art that storing a paper in a roll or in stack is commonly practiced.

With respect to claim 11, the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust viscosity of coating solutions of a recording medium in order to optimize the coating properties of a layer. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

With respect to claims 15 and 16, the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of

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12. Claims 6, 11, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sismondi et al. (US 6,387,473 B1), as applied to claims 1-5, 7, 9, 10, 12 and 13 in paragraph #8.

With respect to claim 6, Sismondi teaches the claimed limitation except for wounding the recording sheet in a roll. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to wound the recording sheet in a roll since it was known in the art that storing a paper in a roll or in stack is commonly practiced.

With respect to claim 11, the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust viscosity of coating solutions of a recording medium in order to optimize the coating properties of a layer. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

With respect to claims 15 and 16, the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust pH value of coating solution(s) of a recording medium in order to optimize printing qualities after imaging. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 703-305-0389. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 703-308-0449. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Betelhem Shewareged
October 31, 2003.